

REMARKS/ARGUMENTS

This RCE and Amendment are filed in response to the Office Action mailed October 20, 2006 for the above-captioned application. Applicant respectfully requests formal reconsideration of the applications as amended.

Applicant has amended Claims 1 and 8 to correct formal errors.

Applicant has argued that Corless fails to teach a unilateral license. The Examiner has responded that Applicants “[have] not contextualized the meaning of ‘unilateral license’ and how it is applied” and that “[i]t is therefore interpreted to be the digital license agreement (col. 5, lines 60-65).” (Office Action at section 5).

Applicant disagrees that the meaning of “unilateral license” is unclear, and further disagree that the specification fails to put it in context. In Applicants’ specification it is explained that in the patent context, there is a danger inherent in a potential licensee identifying itself to a potential licensor. (See paragraphs [0002] – [2004]). Specifically, if the potential licensee is identifiable by the licensor prior to formation of a contract, the licensee may become a target of infringement litigation. Thus, Applicant’s claims specifically require a unilateral license be offered by the licensor, and distinguish over previous offerings which contemplated bilateral licenses (See Paragraph [0005]). Applicants’ description of “unilateral license” offers further context in that Applicant even provides a specific example of such a license in Fig. 6. Note that the license shown in the Figure only has a signature block for the licensee, and not the licensor, because it only requires acceptance by the licensee to become a binding contract. The remainder of Applicants’ specification provides context as to how such a unilateral license is used to eliminate problems suffered by willing buyers and sellers prevented from transacting business in the most economically efficient way possible by the consequences of the licensee requesting certain information from the licensor that is typically required prior to completion of the transaction.

The Examiner states that Corless discloses the claimed “unilateral license” at col. 5, lines 60-65. This is false. The text pointed to by the Examiner is quoted below:

"In one embodiment, digital license agreement (DLA) 230 is an intellectual property element describing a licensing agreement for intellectual property 202. Digital license request (DLR) 235 describes a request made for a digital license, and DLR (e) describes an actual digital license agreement between the intellectual property owner and a licensee." (emphasis added).

As explained above, a unilateral license is one that can be accepted by the licensee without the licensee needing to make a request of the licensor, which will necessarily be an information disclosing act. But, the licensee discussed in the paragraph quoted by the Examiner is accessed via a "Digital License Request (235)." (emphasis added).

Similarly, in the text recited by the Examiner at col. 6, last line – col. 7, lines 1-10, "e-commercee site 320 initiates a request (e.g., DRR 215 or DLR 235) to web site 310." The web site later "responds." (See col. 7, at lines 3-4).

The pending claims recite a unilateral license that may be accepted by a licensee, not a license that must be requested. Applicant submits that Corless does not teach a unilateral license because it instead teaches a requested license. To the extent that Corless is ambiguous as to what sort of license is contemplated, its faults may not be cured through the application of the doctrine of inherency because this doctrine requires that the missing subject matter be necessarily and always present, not simply possible or even probable.

In view of the above, Applicant respectfully requests reconsideration and allowance of the Application.

Respectfully submitted:



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